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10/044,676	01/11/2002	Barry Bronson	10008364-1	9715

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EXAMINER

PHAM, HAI CHI

ART UNIT

PAPER NUMBER

2861

DATE MAILED: 12/01/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/044,676	BRONSON, BARRY
	Examiner Hai C Pham	Art Unit 2861

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 15 September 2003.

2a) This action is FINAL.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-14, 16, 17 and 19-23 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) 22 and 23 is/are allowed.

6) Claim(s) 1-14, 16, 17 and 19-21 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. §§ 119 and 120

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

13) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

a) The translation of the foreign language provisional application has been received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

#### Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.

4) Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.

5) Notice of Informal Patent Application (PTO-152)

6) Other: \_\_\_\_\_.

**FINAL REJECTION**

***Response to Amendment***

1. The Declaration filed on 09/15/03 under 37 CFR 1.131 has been considered but is ineffective to overcome the Honda reference, U.S. Patent Application Publication No. 2002/0191517A1.
2. The evidence submitted is insufficient to establish a conception of the invention prior to the effective date of the Honda reference. While conception is the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another. Conception is more than a vague idea of how to solve a problem. The requisite means themselves and their interaction must also be comprehended. See *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897). The declaration fails to provide proof of original exhibits of drawings or records, or photocopies thereof, e.g., lab book, notes, which should form part of the declaration, or any satisfactorily explanation of their absence such that the conception of the invention prior to the effective date of the Honda reference could be established.
3. The evidence submitted is insufficient to establish diligence from a date prior to the date of reduction to practice of the Honda reference to either a constructive reduction to practice or an actual reduction to practice. Although due diligence taken by the Applicant to the filing of the Application has been expressed, there is no evidence of such diligence being provided by the third party in filing the Application.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claim 6 is rejected under 35 U.S.C. 112, first paragraph, because the recited limitations are not supported by either the specification or the drawings, e.g., "wherein said laser head comprises a read laser and a writing laser positioned above said disk storage medium and further comprises an additional read laser positioned below said disk storage medium (emphasis added)". Both the specification and Figure 2 show the read laser (108) and a writing laser (109) being positioned below the disk storage medium while the label printer writing device (214) is positioned above the disk storage medium.

Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical

Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

7. Claims 1-5, 7, 10 are rejected under 35 U.S.C. 102(e) as being anticipated by Honda et al. (Pub. No. U.S. 2002/0191517 A1).

Honda et al. discloses a method and apparatus for printing label on an optical disk, which comprises a disk storage medium (optical disk 10) including a thermally-sensitive layer (heat-sensitive layer 18) (paragraph [0030]) formed on at least a portion of an upper surface of said disk storage medium (Fig. 1), a rotational drive (spindle motor/spindle servo) for rotating said disk storage medium, a transverse drive including a laser head (laser diode of the optical pick-up 66 transversely moved by the feed motor 72) for moving a laser of said disk drive substantially transversely with respect to said disk storage medium. Honda et al. teaches the symbol set (graphic image or character as well as the label printer driver (coordinates of the label to be printed on the optical disk with respect to that of the optical disk) (paragraph [0038])) being stored in and provided by an external device, e.g., host computer, and a processor (system control 62) communicating with the external device, the rotational drive, the transverse drive, and the laser, and wherein the processor uses the label printer driver (coordinates of the label with respect to the coordinate reference of the optical disk as instructed on the basis of the image data) (paragraph [0047]) to control

said rotational drive and the transverse drive in order to thermally write the symbol set to the thermally-sensitive layer of the disk storage medium using the laser.

With regard to claims 2-4, Honda et al. teaches the image data of the label including information of the coordinates of the label printing area with respect to coordinates of the optical disk such that the translation drive of the optical pickup and the spindle motor can be controlled during the label printing.

With regard to claim 5, Honda et al. teaches the laser head comprising a read laser and a writing laser (enclosed in the optical pickup 66) positioned below said disk storage medium, with said writing laser being used to thermally write to said thermally-sensitive layer (18).

With regard to claim 10, Honda et al. teaches rotating the optical disk (via spindle motor), transversely moving the optical pickup containing the laser (via feed motor), tracking a transverse position of the laser (via tracking servo (78) during the label printing by the laser.

#### ***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 6, 8, 9, 11-14, 16-17, 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Honda et al. in view of Kahle (U.S. 6,074,031).

With regard to claim 12, Honda et al. discloses the method of label printing including the steps of loading a symbol set (loading label information as graphic image or character from a host computer) to a processor (system control 62) controlling a disk drive (Fig. 6), with said symbol set including one or more predetermined symbols or graphics to be written to said disk storage medium (10), heating with a laser (within the optical pickup 66) a thermally-sensitive layer (heat-sensitive layer 18) formed on at least a portion of an upper surface of said disk storage medium (Fig. 1), and manipulating said laser with respect to said disk storage medium (based on the label image information).

However, Honda et al. fails to teach the alignment mark for aligning complete label, the alignment mark being pre-printed. Although Honda et al. suggests that the label printer can be provided as a stand-alone system from the regular read/write system of the CD recorder, Honda et al. fails to teach the separate label printer being positioned above the optical disk while the read/write laser head is disposed below the optical disk.

Kahle, an acknowledged prior art, discloses a method and apparatus for printing labels on digital recording media, the apparatus includes an independent label printer (12) positioned above the optical disk, separate from the read/write laser head disposed on the other side of the disk (col. 4, lines 45-65). Kahle further teaches the provision of the pre-printed orientation mark (24) on the surface of the disk for use in sensing the speed of the disk during the label printing process as well as for indicating a reference position or orientation of the disk for aligning the label printing area.

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the device of Honda et al. with the aforementioned teachings of Kahle. The motivation for doing so would have been to provide means for accurately locating the label printing area on the surface of the disk while in rotation.

With regard to claim 19, Honda et al. further teaches the laser comprising a writing laser (the laser being used for both label writing and data recording) positioned below said disk storage medium, and further comprising the preliminary step of detecting an orientation of said disk storage medium (detecting the orientation mark 24), and wherein the heating step is performed by said writing laser and the loading, heating, and manipulating steps are performed if said disk storage medium is inverted. (paragraph [0040]).

With respect to claim 21, Honda et al. further teaches the steps of rotating said disk storage medium, transversely moving said laser with respect to said disk storage medium, tracking a rotational position of said disk storage medium in a rotational position variable, and tracking a transverse position of said laser in a transverse position variable, wherein said rotational position and said transverse position are used by said processor for manipulating said laser with respect to said disk storage medium (Fig. 6).

***Allowable Subject Matter***

10. Claims 22 and 23 are allowed.

11. The primary reason for the indication of the allowability of the claimed invention with respect to claims 22 and 23 have been indicated in the previous Office action with regard to the respective claims 15 and 18.

***Response to Arguments***

12. Applicant's arguments filed 09/15/03 have been fully considered but they are not persuasive due to the ineffectiveness of the declaration for overcoming the Honda reference as presented in the above paragraphs 1-3.

***Conclusion***

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hai C Pham whose telephone number is (703) 308-1281. The examiner can normally be reached on T-F (8:30-5:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Benjamin R. Fuller can be reached on (703) 308-0079. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7722, (703) 308-7724, (703) 308-7382, (703) 305-3431, (703) 305-3432.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.



HAI PHAM  
PRIMARY EXAMINER

November 25, 2003